

Appln. No. 10/719,246  
Amendment dated September 14, 2005  
Reply to Office Action mailed December 30, 2004

**Amendments to the Drawings**

The attached sheets of drawings includes changes to Figs. 1 and 3. These sheets, which includes Figs. 1 and 3, replaces the original sheets including Figs. 1 and 3

Attachment: Replacement Sheets

**REMARKS**

Reconsideration is respectfully requested.

Claims 1 through 17 remain in this application. Claim 18 has been added.

The Examiner's rejections will be considered in the order of their occurrence in the Office Action.

**Paragraph 2 of the Office Action**

The drawings have been objected to.

Submitted under separate cover and addressed to the Examiner is applicant's proposed amendment of the drawing. Specifically, in Figures 1 and 3 of the drawings as originally filed, the upper reference number "28" on the left side of Figure 1 was change to "20" and the reference number "48" on the left side of Figure 3 has been changed to "42". With respect to the reference number "22" attention is directed to the left side of Figure 1 as originally filed which shows reference number "22".

In light of the proposed drawing amendment, it is therefore submitted that the objection to the drawings as originally filed has been overcome, and withdrawal of the objection to the drawings is respectfully requested.

**Paragraphs 3 and 4 of the Office Action**

The specification has been objected to for the informalities noted in the Office Action.

The specification has been amended in a manner believed to clarify any informalities in the language, particularly at the points identified in the Office Action.

Withdrawal of the objection is respectfully requested.

**Paragraphs 5 and 6 of the Office Action**

Claims 13 and 14 have been rejected under 35 U.S.C. §112 (first paragraph) as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to make and/or use the invention.

Claim 14 and the specification have been amended in a manner believed to clarify any informalities in the language, particularly at the points identified in the Office Action. Additionally, the numbers removed from the specification have been removed from Figure 3.

Withdrawal of the §112 (first paragraph) rejection of claims 13 and 14 is respectfully requested.

**Paragraphs 7 and 8 of the Office Action**

Claims 8, 9, 15 and 16 have been rejected under 35 U.S.C. §112 (second paragraph) as being indefinite.

The above amendments to the claims are believed to clarify the requirements of the rejected claims, especially the particular points identified in the Office Action.

Withdrawal of the §112 rejection of claims 8, 9, 15 and 16 is therefore respectfully requested.

**Paragraphs 9 and 10 of the Office Action**

Claims 1-10 and 13-17 have been rejected under 35 U.S.C. §102(b) as being anticipated by Greenberg (Des. 191,832).

In regard to claim 1, it is submitted that the Greenberg reference does not disclose, teach or suggest "a plurality of sliding members coupled to and extending from a face of said sheet of material for forming a grid of sliding members whereby said sheet of material is adapted for facilitating sliding an item placed on said sheet of material on a support surface when said sliding members are positioned to contact the support surface". The Greenberg reference teaches a toboggan that fails to teach the plurality of sliding member being positioned to form a grid on the face of the sheet of

Appln. No. 10/719,246  
Amendment dated September 14, 2005  
Reply to Office Action mailed December 30, 2004

material as claimed by the applicant. Further, for claims to be anticipated by a reference that reference must describe every element of those claims as well as those elements must be arranged as is required by the claims as expressed in MPEP 2131 stated below.

“A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” Verdegaal Bros. v. Union Oil Co. of California, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987).

“The identical invention must be shown in as complete detail as is contained in the ... claim.” Richardson v. Suzuki Motor Co., 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). The elements must be arranged as required by the claim, but this is not an *ipsissimis verbis* test, i.e., identity of terminology is not required. *In re Bond*, 910 F.2d 831, 15 USPQ2d 1566 (Fed. Cir. 1990). Note that, in some circumstances, it is permissible to use multiple references in a 35 U.S.C. 102 rejection. See MPEP § 2131.01.”

Therefore, it is submitted that the Greenberg reference would not lead one to anticipate the combination of features as claimed by the applicants.

Withdrawal of the §102(b) rejection of claims 1-10 and 13-17 is therefore respectfully requested.

#### Paragraph 11 of the Office Action

Claims 1-10 and 13-17 have been rejected under 35 U.S.C. §102(b) as being anticipated by Buening et al. (3,666,282).

In regard to claim 1, it is submitted that the Buening reference does not disclose, teach or suggest “a plurality of sliding members coupled to and extending from a face of said sheet of material for forming a grid of sliding members whereby said sheet of material is adapted for facilitating sliding an item placed on said sheet of material on a support surface when said sliding members are positioned to contact the support surface”. The Buening reference teaches a toboggan that fails to teach the plurality of

sliding member being positioned to form a grid on the face of the sheet of material as claimed by the applicant. Further, for claims to be anticipated by a reference that reference must describe every element of those claims as well as those elements must be arranged as is required by the claims as expressed in MPEP 2131 stated below.

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." Verdegaal Bros. v. Union Oil Co. of California, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987).

"The identical invention must be shown in as complete detail as is contained in the ... claim." Richardson v. Suzuki Motor Co., 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). The elements must be arranged as required by the claim, but this is not an *ipsissimis verbis* test, i.e., identity of terminology is not required. In re Bond, 910 F.2d 831, 15 USPQ2d 1566 (Fed. Cir. 1990). Note that, in some circumstances, it is permissible to use multiple references in a 35 U.S.C. 102 rejection. See MPEP § 2131.01."

Therefore, it is submitted that the Buening reference would not lead one to anticipate the combination of features as claimed by the applicants.

Withdrawal of the §102(b) rejection of claims 1-10 and 13-17 is therefore respectfully requested.

**Paragraph 12 of the Office Action**

Claims 1-10 and 13-17 have been rejected under 35 U.S.C. §102(b) as being anticipated by Dickhaut et al. (Des. 374,846).

In regard to claim 1, it is submitted that the Dickhaut reference does not disclose, teach or suggest "a plurality of sliding members coupled to and extending from a face of said sheet of material for forming a grid of sliding members whereby said sheet of material is adapted for facilitating sliding an item placed on said sheet of material on a support surface when said sliding members are positioned to contact the support surface". The Dickhaut reference teaches a body snow sled that fails to teach the plurality of sliding member being positioned to form a grid on the face of the sheet of material as claimed by the applicant. Further, for claims to be anticipated by a reference that reference must describe every element of

Appln. No. 10/719,246  
Amendment dated September 14, 2005  
Reply to Office Action mailed December 30, 2004

those claims as well as those elements must be arranged as is required by the claims as expressed in MPEP 2131 referenced above. Therefore, it is submitted that the Dickhaut reference would not lead one to anticipate the combination of features as claimed by the applicants.

Withdrawal of the §102(b) rejection of claims 1-10 and 13-17 is therefore respectfully requested.

**Paragraph 14 of the Office Action**

Claims 11 and 12 have been rejected under 35 U.S.C. Section 103(a) as being unpatentable over Greenberg (Des. 191,832) or Buening et al. (3,666,282) or Dickhaut et al. (Des. 374,846) in view of Field (3,734,523).

It is submitted that the combination of Greenberg or Buening or Dickhaut with Field is not suggested by the prior art, and even if such a combination were to be made, one would not be led to the combination of features recited in applicants' claims. In particular, the references do not disclose, teach or suggest "a plurality of sliding members coupled to and extending from a face of said sheet of material for forming a grid of sliding members whereby said sheet of material is adapted for facilitating sliding an item placed on said sheet of material on a support surface when said sliding members are positioned to contact the support surface". As discussed above, the Greenberg, Buening and Dickhaut references fail to teach the plurality of sliding member being positioned to form a grid on the face of the sheet of material as claimed by the applicant. The Field reference teaches a slalom sled that fails to teach the plurality of sliding member being positioned to form a grid on the face of the sheet of material as claimed by the applicant. It is also submitted that the mere fact that one may argue that the prior art is capable of being modified to achieve a claimed structure does not by itself make the claimed structure obvious--there must be a motivation provided by the prior art, and that motivation is totally lacking in the reference.

The examiner finds the claimed shape would have been obvious urging that (our emphasis) "it is obvious for one skilled in the art to form

Appln. No. 10/719,246  
Amendment dated September 14, 2005  
Reply to Office Action mailed December 30, 2004

each hook base of any desired shape \*\*\* since *this is within the capabilities of such a person.*" Thus, the examiner equates that which is within the capabilities of one skilled in the art with obviousness. Such is not the law. There is nothing in the statutes or the case law which makes "that which is within the capabilities of one skilled in the art" synonymous with obviousness.

Ex parte Gerlach and Woerner, 212 USPQ 471 (PTO Bd. App. 1980) (emphasis in original).

Therefore, it is submitted that the combination of the Greenberg or Buening or Dickhaut references with the Field reference would not lead one to the combination of features as claimed by the applicant.

Withdrawal of the §103(a) rejection of claims 11 and 12 is therefore respectfully requested.

**New Claims:**

New claim 18 has been added to vary the scope of the claims and clarify the present invention. All limitations are supported by the original disclosure including the specification, drawings and original claims. Claim 18 incorporates the limitations of limitations of claims 1 through 12 and as discussed above the references cited in the Office Action fail to teach the sliding member being arranged in a grid and therefore claim 18 is believed to be in condition for allowance. Therefore, no new matter has been added. The new claim is believed to be allowable.

Appln. No. 10/719,246  
Amendment dated September 14, 2005  
Reply to Office Action mailed December 30, 2004

**CONCLUSION**

In light of the foregoing amendments and remarks, early reconsideration and allowance of this application are most courteously solicited.

Respectfully submitted,

LEONARD & PROEHL, Prof.L.L.C.



Date: SEPT. 14, 2005

Jeffrey A. Proehl (Reg. No. 35,987)  
Customer No. 40, 158  
3500 South First Avenue Circle, Suite 250  
Sioux Falls, SD 57105-5807  
(605)339-2028 FAX (605)336-1931